



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/052,470	01/23/2002	Carolyn Caes	05725.0347-01	9229

22852 7590 11/19/2002

FINNEGAN, HENDERSON, FARABOW, GARRETT &
DUNNER LLP
1300 I STREET, NW
WASHINGTON, DC 20006

EXAMINER

GEORGE, KONATA M

ART UNIT	PAPER NUMBER
----------	--------------

1616

DATE MAILED: 11/19/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/052,470

Applicant(s)

CAES ET AL.

Examiner

Konata M. George

Art Unit

1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 October 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 49-78 is/are pending in the application.
- 4a) Of the above claim(s) 51-66 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 50,68,72,76 and 78 is/are allowed.
- 6) ☒ Claim(s) 49,50,67,69,71,73-75 and 77 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892).
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claims 49-78 are pending in this application.

Information Disclosure Statement

1. The information disclosure statement (IDS) submitted on March 23, 2002 was noted and the submission is in compliance with the provisions of 37 CFR 1.97.

Accordingly, the examiner will consider the information disclosure.

Restriction Requirement

2. Applicant's election with traverse of Group I, claims 49 and 50, in Paper No. 6 are acknowledged. The traversal is on the ground(s) that examining all the claims would not be a serious burden. This is not found persuasive because the inventions are independent and distinct. Applicant has not pointed out any errors in the restriction requirement nor shown that the inventions are not patentability distinct. Burden of search is not the sole reason for the restriction.

The requirement is still deemed proper and is therefore made FINAL.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Art Unit: 1616

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 49, 67, 69, 71, 73, 75 and 77 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-35 of U.S. Patent No. 6,423,306 B2. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reasons. Claim 49 is directed to a transfer resistant composition comprising at least one copolymer selected from tri-block, multi-block and radial copolymers and the patent is directed also to transfer resistant compositions comprising an effective amount of at least one radial block copolymer. It is the position of the examiner that if one were to choose the radial copolymer of the instant invention then it was read on the invention of the patent.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 49, 50, 73, 74 and 77 are rejected under 35 U.S.C. 103(a) as being unpatentable over DesLauriers et al. (US 5,221,534).

DesLauriers discloses a composition for health and beauty aid comprising an hydrocarbon oil and a blend of polymers consisting of at least two selected from the group consisting of di- and tri-block copolymers, radial and multi-block polymers

Art Unit: 1616

wherein the blend contains at least on tri- or di-block copolymer (col. 2, lines 35-46).

The composition may contain one or more health and beauty aids (col. 6, lines 64 and col. 7, lines 1-10) and additional film former are taught in col. 6, lines 34-44 and table 11 and is in the form of soft gels that are used for make-up, mascara, etc. (col. 7, lines 28-31). It is the position of the examiner that since the gels are used for make-up and mascara the composition will contain film-forming agents that would add in adhering the polymers to the skin although not mentioned in the prior art.

Thus it would have been obvious to one of ordinary skill in the art at the time the invention was made to use film-forming agents in the formulation of mascara for the purposes of leaving a transfer resistant film layer on the skin.

Allowable Subject Matter

5. Claims 67, 69, 71 and 75 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

6. Claims 68, 70, 72, 76 and 78 are allowed.

Conclusion

7. Claims 49, 67, 69, 71, 73, 75 and 77 stand rejected.

8. Claims 68, 70, 72, 76 and 78 are allowed.

9. Claims 51-66 are withdrawn from consideration as they are directed towards non-elected claims.

Art Unit: 1616

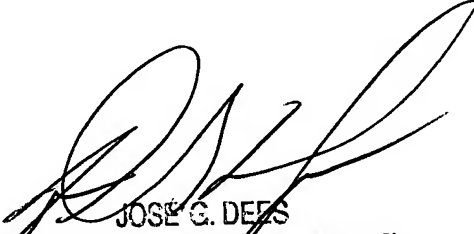
Telephone Inquiries

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Konata M. George, whose telephone number is (703) 308-4646. The examiner can normally be reached from 8AM to 5:30PM Monday to Thursday, and on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, José Dees, can be reached at (703) 308-4628. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4556 for regular communications and for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

Konata M. George


JOSE G. DEES
SUPERVISORY PATENT EXAMINER
1616